



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/718,578

11/24/2003

Michael Alan Morris

025265-270

1700

21839 7590 01/18/2007
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1732

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
|--|-----------|---------------|

3 MONTHS

01/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/718,578

Applicant(s)

MORRIS ET AL.

Examiner

Mathieu D. Vargot

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/24/2003.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Volk (see Fig. 6; col. 3, lines 12-17; col. 5, line 63; col. 9, line 64 through col. 10, line 6; col. 10, line 18 and lines 46-68).

Volk discloses the instant method of making a steeply curved lens element adapted for mounting in eyewear—spectacle frames (col. 10, line 18)—wherein a lens blank is molded (col. 2, lines 12-17) with a radius of curvature less than 35 mm over a substantial portion of the front surface (see the curvatures shown in Fig. 6), cutting a back surface (col. 10, lines 46-68) of the lens blank (passage bridging columns 9 and 10) to provide the desired prescription through power and edging the lens blank (col. 10, lines 19-20). It is rather clear from Figure 6 of Volk that the final lens has a hollow depth of greater than 8 mm, in that the perpendicular distance from the optical center of the posterior curve to the edge of the lens must be much greater than 10.183 mm. The 10.183 mm is obtained by subtracting the thickness of the lens (ie, 8 mm) from the 18.183 mm dimension shown on the left side of the figure. The front surface of the lens element provides a progressive lens surface—see col. 5, line 63. Concerning instant claim 3, see column 10, line 74, wherein the back surface is ground using a toric tool, such seen to include the instant “circular meridian toroid”. Concerning instant claim 5, it is submitted that the cutting operations disclosed at columns 10 and 11 of Volk would

Art Unit: 1732

inherently involve the forming of a progressive surface at the back surface of the lens, as such appear to involve the same operations performed on the front surface.

2.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volk.

Volk discloses the basic claimed process of making a lens element as set forth in paragraph 1, supra, the reference essentially lacking a clear teaching that the back surface grinding forms a progressive surface (ie, claim 5) and that the lens element is molded such that it has no through power due to its molded front and back surfaces. It is submitted that these would have been obvious modifications to the process disclosed in Volk dependent on the exact lens desired. Clearly, if it were known in Volk to fashion progressive surfaces on the front of the lens, then it would be obvious to do so on the rear surface of the lens. Also, it would have been obvious to employ molds that would have provided whatever desired front and back surface should one desire not to grind the surfaces after molding. It is noted that such is fairly well known in the art and is generally done in situations where only certain lenses are needed, or where molds exist for whatever types of lenses are required. However, this would not be a patentable advance over that disclosed in Volk. Also, making the molding surfaces of the molds so that the resultant lens molded therefrom has zero through power would have been


obvious dependent on the exact type of lens molded. If one did not require a prescription lens—ie, a corrective lens—then it certainly would have been obvious to modify the method of Volk to remove these aspects. The elimination of steps and their functions is always within the purview of one of ordinary skill in the art.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
January 15, 2007


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

1/15/07